

CERTIFICATION OF FACSIMILE TRANSMISSION

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David W. Hibler

41,071

(Reg. No.)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICEAppellant(s): Turner Jr. *et al.*

Group Art Unit: 1647

Application No.: 09/689,911

Appcal No.: 2005-2379

Filed: 10/11/2000

Examiner: B. Bunner

Title: Polynucleotides Encoding Human Galanin
Family Proteins (As Previously Amended)

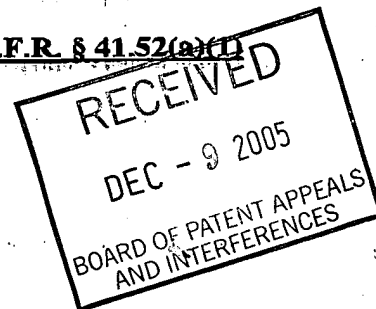
Atty. Docket No.: LEX-0068-USA

REQUEST FOR REHEARING UNDER 37 C.F.R. § 41.52(a)(1)**Mail Stop Appeal Brief - Patents**

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450



Sir:

Appellants acknowledge the receipt of the Decision on Appeal ("the Decision") from the Board of Patent Appeals and Interferences ("the Board") in the above-referenced case, mailed on November 30, 2005, which has been carefully reviewed and studied. Appellants herein request rehearing, as discussed in detail below.

As set forth in 37 C.F.R. § 41.52(a)(1), the time limit for filing a request for rehearing is "within two months from the date of the original decision". The present request for rehearing is therefore timely filed, and Appellants believe no fees are due in connection with this request. However, the Commissioner is authorized to charge any required fees or credit any overpayment to Deposit Account No. 50-0892.

REQUEST FOR REHEARING

As set forth in 37 C.F.R. § 41.52(a)(1), "(t)he request for rehearing must state with particularity the points believed to have been misapprehended or overlooked in rendering the decision". Appellants respectfully submit that the Board, in asserting that "Appellants have presented no evidence to show that Ohtaki [Ohtaki *et al.* (*J. Biol. Chem.* 274:37041-37045, 1999)] represents the state of the art as of this application's effective filing date" (the Decision at page 6), appears to have overlooked evidence of record in the present case. Specifically, Appellants fully addressed this exact issue in the response filed on October 21, 2005 ("the Response") to the Order Under 37 C.F.R. § 41.50(d) ("the Order") issued from the Board on September 23, 2005, and since no mention of Appellants' arguments as set forth in the Response are to be found anywhere in the Decision, it is Appellants' belief that these arguments have been overlooked.

In the Order at page 3, footnote 3 ("footnote 3"), the Board stated:

Appellants cite a paper published in December 1999 as describing and characterizing a protein that 'shares 100% identity at the amino acid level with the first 98 amino acids' with SEQ ID NO:2. The instant application, however, has an effective filing date of October 1999 and Appellants have not shown that the later-published paper reflects the state of the art as of the filing date.

With regard to the Board's contention that "Appellants have not shown that the later-published paper reflects the state of the art as of the filing date", Appellants respectfully pointed out that in the first Official Action on the merits in the present case, mailed on April 1, 2002 ("the First Action"), the Examiner made two references of record in the present case (the First Action at page 13): 1) Ohtaki *et al.* (*J. Biol. Chem.* 274:37041-37045, 1999; "Ohtaki"); and 2) Ohtaki *et al.*, PCT Patent Application Publication Number WO 99/48920 ("WO 99/48920"). Appellants respectfully pointed out that WO 99/48920 was published in Japanese, so merely for the convenience of the Board Appellants focused their arguments on Ohtaki, which was published in English, instead of WO 99/48920. However, Appellants noted for the record that WO 99/48920 discloses the DNA and amino acid sequence of porcine GALP (SEQ ID NOS:27 and 29, respectively), as well as the amino acid sequences of the processed porcine, rat, and human GALP (1-60) (SEQ ID NOS:31, 33, and 34, respectively), and also discloses that GALP preferentially activates the galanin receptor GALR2 relative to GALR1 (see Figure 2 of WO 99/48920), exactly as was disclosed in Ohtaki. Importantly, WO 99/48920 was published on September 30, 1999, 12 days before the effective filing date of the present application (October 12, 1999). Appellants further noted that Ohtaki was received

for publication on October 8, 1999 (see Ohtaki at page 37041), 4 days before the effective filing date of the present application. Therefore, Appellants pointed out that as the art made of record by the Examiner in the First Action was clearly pre-filing date art, "the state of the art as of the filing date" was not believed to be an issue in the present case, since the art of record establishes on its face that the information contained therein "reflects the state of the art as of the filing date". Therefore, the Board's assertion that "Appellants have presented no evidence to show that Ohtaki represents the state of the art as of this application's effective filing date" is clearly erroneous, based on the evidence presented to the Board in the Response. As this evidence appears to have been overlooked by the Board, Appellants respectfully request a rehearing of the present Appeal Brief.

Appellants additionally noted in the Response that in a recent Decision on Appeal in a commonly assigned application (see Appeal No. 2005-1285, decided August 31, 2005), the Board has looked favorably on pre-filing date evidence in support of patentability in overcoming rejections under 35 U.S.C. § 101 as allegedly lacking a patentable utility, and under 35 U.S.C. § 112, first paragraph as allegedly unusable by the skilled artisan due to the alleged lack of patentable utility.

As set forth in the Appeal Brief, Appellants need only make one credible assertion of utility to meet the requirements of 35 U.S.C. § 101 (*Raytheon v. Roper*, 220 USPQ 592 (Fed. Cir. 1983); *In re Gottlieb*, 140 USPQ 665 (CCPA 1964); *In re Malachowski*, 189 USPQ 432 (CCPA 1976); *Hoffman v. Klaus*, 9 USPQ2d 1657 (Bd. Pat. App. & Inter. 1988)). Based on the evidence presented to the Board in the Response, as well as those set forth in the Appeal Brief, Appellants contend that the present claims clearly meet the utility requirements of 35 U.S.C. §§ 101 and 112, first paragraph. Therefore, Appellants respectfully request that the Board overrule the Examiner's rejections of claims 1-8 under 35 U.S.C. §§ 101 and 112, first paragraph in the present case.

Respectfully submitted,

December 9, 2005

Date



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Date: December 9, 2005

Phone:

Pages: 4 (including coversheet)

Re: Appeal No. 2005-2379
Application Serial Number: 09/689,911
Atty. Dkt. No. LEX-0068-USA

CC: File

•Comments:

Please find attached a Request for Rehearing Under 37 C.F.R. § 41.52(a)(1) in reference to the above-referenced appeal. Please contact me at the number shown above if there are any questions.

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DEC - 9 2005

BOARD OF PATENT APPEALS
AND INTERFERENCES